

REMARKS

Presently, claims 1-4, 6-10, 12-15 and 17-51 stand rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by *Van Zoest et al* (U.S. Patent No. 6,609,105) ("Van Zoest"). Claims 5 and 11 also stand rejected pursuant to 35 U.S.C. § 103, over *Van Zoest et al* in view of Official Notice concerning installation in an automobile and ATRAC3 format. The Applicant respectfully traverses the rejections and requests reconsideration in view of remarks herein. Applicant further requests that the Examiner allow new claims 52-55 which further claim novel and non-obvious subject matter not disclosed in the relied on references.

(A) Rejections of Claims 1-51 over Van Zoest

In the present Office Action, the Examiner has maintained the prior rejection over the submission of 37 C.F.R. § 1.131 declarations that establish that the Applicant conceived of the invention prior to the priority date of the *Van Zoest* reference and also exercised reasonable diligence through the constructive reduction to practice associated with the Applicant's filing of the provisional patent application related to the present application (60/203,684, filed May 12, 2000).

However, notwithstanding the prior submissions, the Examiner has concluded that (1) Exhibit A does not clearly describe the invention (Office Action at 13), and (2) that the Applicant has not submitted evidence of reduction to practice (Office Action at 13). Applicant respectfully requests that the Examiner reconsider for the following reasons.

(1) Every last Detail need not be Corroborated

It is well-established that when a party seeks to prove conception via the oral testimony of the inventor, that party must proffer evidence corroborating that testimony. See *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996). This rule addresses the concern that a party claiming

inventorship might be tempted to describe his actions in an unjustifiably self-serving manner in order to obtain a patent or to maintain an existing patent. See *Kridl v. McCormick*, 105 F.3d 1446, 1450 ("The tribunal must also bear in mind the purpose of corroboration, which is to prevent fraud, by providing independent confirmation of the inventor's testimony.") However, there is no particular formula that an inventor must follow in providing corroboration of his testimony of conception. See *Kridl*, 105 F.3d at 1450. Rather, whether an inventor's testimony has been sufficiently corroborated is determined by a "rule of reason" analysis, in which "[a]n evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached." *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed.Cir. 1993). In other words, an accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. MPEP 715.07 (700-250); See also *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

Applicant submits that the previously filed declarations of Inventor Gudorf sufficiently establish the prior conception of the invention under the "rule of reason" analysis in view of the Exhibit A as explained by Inventor Gudorf. In view of the details of the Exhibit A including sending files to disc space on a "Your Music Server" and providing "secure" access to the files with "qualified" net enabled devices, which has been explained by Inventor Gudorf, it is more than clear that Gudorf's testimony is credible and conception of the elements in question was prior to the relied on reference.

Nevertheless, Applicant submits the further Declaration of Marc Beckwitt, a co-worker of Inventor Gudorf in the time frame of conception to further corroborate that element that the Examiner contends is only vaguely disclosed in Exhibit A. Marc

Beckwitt's declaration further confirms the conception of the elements of claims relating to (b) associating the audio files with authentication identification information, (c) storing the audio files at the central location on at least a portion of a storage media uniquely associated with the authentication identification information and (d) receiving at the central location the authentication identification information from a second device.

Applicant therefore requests that the Examiner reconsider the basis of the present rejection.

(2) Evidence of Actual Reduction is Not Necessary

The Examiner also contends that actual reduction to practice has not been shown. Applicant respectfully submits that evidence of an actual reduction to practice is not necessary. Prior conception and reasonable diligence through a constructive reduction to practice may be relied upon to disqualify a cited reference. See MPEP 715.07 (700-250).

Applicant's previously submitted declarations establish diligence to a constructive reduction to practice in the form of the filing of Applicant's provisional patent application (60/684,203). Applicant respectfully refers the Examiner to the declarations discussing diligence to the Applicant's provisional application filing date (Declarations of Messrs. Littenberg and Tobin). Applicant further refers the Examiner to Applicant's provisional patent application discussing the Applicant's invention including at least page 7 in addition to the pages of Exhibit A which were filed as part of the provisional patent application.

Thus, Applicant requests that the Examiner reconsider the basis of the present rejection.

(B) Van Zoest does not Disclose all Elements of Applicant's invention

Finally, Applicant requests that the Examiner reconsider the rejection over Van Zoest in further view of new claims 52-55. For example, independent claim 52 defines:

A method for storing audio files for use by multiple users to prevent access to an authorized user's audio files by other authorized users comprising:

(a) receiving at a central system a plurality of electronic files representing audio signals for the purpose of storing the plurality of files at the central system for multiple users,

(b) storing a plurality of sets of electronic files of the plurality of audio files at the central system, each set being uniquely associated with authentication identification information of a user,

(c) receiving at said central location authentication identification information of a user from a device, and

(d) transmitting audio files of a set of audio files to said device upon receipt of said authentication identification information of the user;

wherein different stored sets of electronic files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information, and

wherein the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device.

This invention is not disclosed by Van Zoest. Van Zoest describes a system in which a user must separately log on before access to a song may be selected. Van Zoest, col. 11, lines 7-31. Applicant's system is discussed in the specification. See, e.g., ¶ 27 and Fig. 4. Accordingly, Applicant requests that claim 52 be allowed. Similarly, claims 53-55 may be compared

with the subject matter of claim 52 and are similarly in condition for allowance.

(c) Conclusion

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

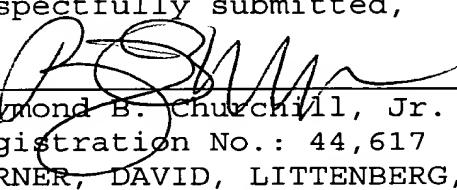
If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By


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